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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,253	03/01/2002	Barbara A. Rincavage	RINCAVAGE-1	4031
25101	7590	07/15/2010	EXAMINER	
Philip D. Freedman PC 1449 Drake Lane Lancaster, PA 17601			RINES, ROBERT D	
			ART UNIT	PAPER NUMBER
			3623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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JUL 15 2010

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In re Application of:	:	DECISION ON PETITION
Barbara A. RINCAVAGE et al.	:	UNDER 37 CFR 1.181
Application No. 10/086,253	:	
Filed: March 01, 2002	:	
For: SYSTEM AND METHOD FOR	:	
FILING MEDICAL PRESCRIPTIONS	:	

This is in response to applicants' petition under 37 CFR 1.181 filed May 11, 2010 requesting withdrawal of the finality of the Office action mailed April 26, 2010.

The petition is **DENIED**.

Applicants allege that the final Office action mailed April 26, 2010 is improper because (1) the examiner failed to address certain limitations of applicants' claims, particularly the feature of "brand and dosage discretion" and (2) the examiner further did not respond to applicants' arguments traversing the examiner's rejections of these claim limitations.

MPEP 707.07(f) sets forth that in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application. Where the requirements are traversed, the examiner should make proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. Further, 37 CFR § 1.104 sets forth the nature of examination and specifically states that (b) the examiner's action will be complete as to all matters and that (c)(2) in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

A review of the record reveals that applicant filed a RCE on October 30, 2009 after a decision by the Board of Patent Appeals and Interferences (hereinafter the Board) on September 3, 2009 affirming the examiner's rejection. In response to the RCE, the examiner issued a non-final Office action on December 16, 2009 rejecting claims 21-22, 27-32 and 37-40 over Denny in

view of Borsand et al., and claims 23-26 and 33-36 over Denny, Borsand et al. and Keresman. Applicant filed a response on January 13, 2010 arguing that the new "brand and dosage discretion" claim limitations have not been addressed. The examiner issued a final Office action on April 26, 2010 maintaining the same rejections for all claims and their limitations. 37 CFR § 1.104 sets forth that, in rejecting claims, the examiner must cite the best references at his or her command and that when a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. In the final Office action, the examiner cited the particular paragraphs of the prior art relied upon for each claim limitation, specifically detailing on pages 6 and 7 the particular paragraphs relied upon to disclose the "brand and dosage discretion" claim limitations (as referencing on page 2, paragraph 4, of applicants' petition) and providing rationale for such a combination on pages 7 and 8 of the action. These rejections were previously presented on pages 7 and 8 in the non-final office action of December 16, 2009 and maintained, as applicants did not amend the claims in the response filed January 13, 2010. Thus, the examiner has provided a complete office action and has addressed all limitations of applicants' claims, namely the "brand and dosage discretion" claim limitations.

Applicant contends that examiner's response is incomplete or inadequate; however, the record shows that the examiner has made a good faith effort to respond to applicant's arguments traversing the prior art rejections of the "brand and dosage discretion" claim limitations in the final Office action dated April 26, 2010. MPEP 707.07(f) sets forth that in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application and that where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the Applicant's argument and answer the substance of it.

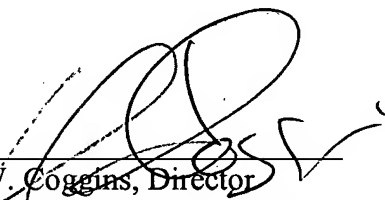
On page 4 of the final Office action, the examiner responds to applicants' arguments and clarifies the prosecution history. The examiner's final Office action was in response to communications filed by applicant January 13, 2010, in which no amendments to the claims were made and applicant reiterated his argument from previous communications filed October 30, 2009 that the prior art does not teach the "brand and dosage discretion". The examiner responded to this argument by reasserting the response to argument set forth in the non-final Office action dated December 16, 2009, as well as the decision by the Board dated September 3, 2009. On pages 13-14 of the non-final Office action, the examiner specifically notes and answers applicant's argument regarding the "brand and dosage discretion" claim limitations. Further, the referenced proceedings before the Board addressed substantially similar issues. Examiner's prior art rejections of previously presented claims 1-20 were affirmed, these claims encompassing substantially similar claim concepts, including the claim limitations "entering filled prescription data into said database" and "differences between said filled prescription data and said unfilled prescription data", and rejected using the same prior art references relied upon in the non-final and the final office actions. Thus, the examiner has clearly and sufficiently responded to applicants' arguments traversing the examiner's rejections.

In light of 37 CFR 706.07(a) which states that "under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of

rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)", the finality of the Office action mailed on April 26, 2010 was proper due to the fact that the examiner maintained the same rejections on un-amended claims.

Furthermore, where differences of opinion concern the denial of patent claims because of prior art, and the questions thereby raised relate to the merits, then the appeal process has long been provided by statute. The MPEP clearly states under 37 CFR 1.191(a) that an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection. Thus, the application of the references to support the rejection of the claims by the examiner in this application is a matter appealable to the Board.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Beth Boswell at (571) 272-6737.



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bvb: 07/07/10

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